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In re Application of	:	DECISION ON
MATSUI	:	
Application No.: 10/561,629	:	PETITION UNDER
PCT No.: PCT/JP2004/008710	:	
Int. Filing Date: 21 June 2004	:	37 CFR § 1.47(b)
Priority Date: 20 June 2003	:	
Attorney Docket No.: 19036/40796	:	
For: OPTHALMIC COMPOSITION	:	

This is a decision on applicant's petition under 37 CFR 1.47(b) and petition under 37 CFR 1.183 filed in the United States Patent and Trademark Office (USPTO) on 07 February 2007 and applicant's petition under 37 CFR 1.182 filed in the USPTO on 16 March 2007.

**BACKGROUND**

On 21 June 2004, applicant filed international application PCT/JP2004/008710, which designated the US and claimed a priority date of 20 June 2003. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 29 December 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 20 December 2005.

On 20 December 2005, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 06 July 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventor in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) were required. The NOTIFICATION set a two-month extendable period for reply.

On 07 February 2007, applicant submitted a petition under 37 CFR 1.47(b) and a petition under 37 CFR 1.183. The petition was accompanied by, *inter alia*, a petition/fee for a five month extension of time, the surcharge under 37 CFR 1.492(h), a declaration of facts by Madoka Yamashita, and a memorandum of law by Tadato Fujiwara.

On 16 March 2007, applicant submitted a petition under 37 CFR 1.182.

### **DISCUSSION**

#### **Petition Under 37 CFR 1.47(b)**

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Items (1) and (6) have been met.

Item (2) has not been met. The declaration of facts by Madoka Yamashita has been considered. As noted in MPEP § 409.03(d), the statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Here, it does not appear that Madoka Yamashita has first-hand knowledge of either the hand-delivery of the application papers to Ms. Matsui or the oral refusal. Regarding the delivery of the application papers, to establish a refusal to sign, it is required that the inventor be presented with the application papers (specification, including claims, drawings, and oath or declaration). See MPEP 409.03(d). "It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956)." MPEP 409.03(d). Regarding the oral refusal of Ms. Matsui, MPEP § 409.03(d) states in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

No firsthand statement of facts by the person to whom the oral refusal was made has been provided. The copies of e-mails and mail labels have been considered to the extent possible without translations having been provided.

Item (3) has not been met. See "Petition Under 37 CFR 1.183" below.

Item (4) has not been met. An oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor has not been provided.

Item (5) has not been met. A copy and a translation of an assignment for Japanese patent application number 2003-176965 has been provided. However, it is not clear that the invention

of that application and the invention of the present application are the same invention. *Cf. In Re Gray*, 115 USPQ 80 (Comm'r Pat. 1956) (An assignment of an application and any "reissue, division, or continuation of said application" does not itself establish an assignment of a continuation-in-part application.) See MPEP 409.03(f).

#### Petition Under 37 CFR 1.183

The petition under 37 CFR 1.183 requests suspension of the requirement of 37 CFR 1.47(b) that the non-signing inventor's last known address be provided. Waiver is requested in view of the Act on the Protection of Personal Information in Japan which went into effect on May 30, 2003.

The petition fee has been paid. The memorandum of law by Tadato Fujiwara has been considered but is not sufficient. Even without translations, it appears that the address that appears on the published international application for Yuka Matsui is her current address (see, e.g., the untranslated letter to Ms. Matsui dated 23 August 2006 included with the submission of 07 February 2007.) It is not clear why the assignee would be prevented from providing publicly available information. Also, the memorandum by Tadato Fujiwara, states that the law prohibits "information on any individual alive, whereby a specific individual can be identified on the basis of descriptions included in said information". However, this would seem to preclude identifying the inventor by name, which the memorandum does not argue is prohibited. Additionally, if applicant's representative in the U.S. were to obtain the last mailing address of Ms. Matsui from someplace or someone other than the assignee, then it would seem that the law of Japan would not be violated. Further still, the violation would seem to be the assignee providing the information to petitioner rather than petitioner providing the information to the USPTO. Finally, it is suggested that a translation of the relevant portion of the law be provided in any renewed petition under 37 CFR 1.183.

#### Petition Under 37 CFR 1.182

The petition under 37 CFR 1.182 requests that the submission filed 16 March 2007 be used as a substitute for the submission filed 07 February 2007 because the submission filed 07 February 2007 includes personal information about Ms. Matsui that is prohibited from being disclosed by Japanese privacy law.

The proper procedure to expunge information submitted in an application is a petition under 37 CFR 1.59(b). Accordingly, the petition under 37 CFR 1.182 is inappropriate. The petition fee has been credited to Deposit Account 13-2855.

#### CONCLUSION


For the above reasons, applicants' petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

For the above reasons, applicant's petition under 37 CFR 1.183 is **DISMISSED** without prejudice.

For the above reasons, applicant's petition under 37 CFR 1.182 is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b) [and/or 37 CFR 1.183]". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

  
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